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**From:** Doughty, Jacob A.

**Sent:** Friday, May 26, 2006 3:24 PM

**To:** AB77.Comments

**Subject:** Comments Regarding Notice of Proposed Rule Making RIN 0651-AB77

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MESSAGE:  
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Re:           Comments Regarding Notice of  
              Proposed Rule Making RIN 0651-AB77  
              "Revisions and Technical Corrections Affecting  
              Requirements for *Ex Parte* and *Inter Partes* Reexamination"

To whom it may concern:

Please see the attached letter.

Best regards,

Jacob A. Doughty

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# OLIFF & BERRIDGE, PLC

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May 26, 2006

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**By E-mail**

Attention: Mr. Kenneth M. Schorr

Re: Comments Regarding Notice of  
Proposed Rule Making RIN 0651-AB77  
"Revisions and Technical Corrections Affecting  
Requirements for *Ex Parte* and *Inter Partes*  
Reexamination"

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Dear Sir:

Please consider the following comments relating to the March 30, 2006 Notice of Proposed Rule Making, entitled "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination."

As a general matter, we believe that the proposed rules are carefully thought out and well drafted. However, we believe that there are several issues raised in the proposed rules, particularly in Proposal II, that appear to introduce unpredictability and place an unnecessary burden on participants in *Inter Partes* Reexamination proceedings, while failing to advance the Patent Office's stated goal of preventing delay in such proceedings. We believe that the proposed rules could be improved as described below.

Under the present rules, in an *Inter Partes* Reexamination proceeding, a patent owner may file a supplemental reply to an Office Action. See 37 C.F.R. §§ 1.111(a)(2), 1.937(b). Such a supplemental reply will not be entered by right, but:

The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;

- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (*e.g.*, typographical errors); or
- (F) Simplification of issues for appeal.

*See* 37 C.F.R. § 1.111(a)(2) (emphasis added). That is, the Patent Office presently has discretion as to whether or not supplemental reply.

The proposed rules would require the patent owner to provide a showing of sufficient cause why a supplemental reply should be entered. In particular, the proposed rules would require that the showing include:

- (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
- (2) An explanation of why the supplemental response could not have been presented together with the original response to the Office action; and
- (3) A compelling reason to enter the supplemental response.

*See* Proposed 37 C.F.R. § 1.945(b).

Ostensibly, the purpose of these additional requirements is to: (i) assist the Patent Office in exercising its discretion to enter supplemental replies pursuant to 37 C.F.R. § 1.111(a)(2), and (ii) discourage patent owners from filing superfluous supplemental replies that merely delay reexamination proceedings. We believe that Proposed 37 C.F.R. § 1.945(b)(1) serves these twin aims. The requirement of an explanation of how the requirements of 37 C.F.R. § 1.111(a)(2)(i) are satisfied provides the Patent Office with an opportunity to consider a patent owner's rationale for why a particular supplemental reply advances prosecution. Likewise, a patent owner that cannot provide a rationale for why a particular supplemental reply advances prosecution will be deterred from filing that reply.

However, we believe that the requirements of Proposed 37 C.F.R. § 1.945(b)(2) and (3) do not aid the Patent Office in exercising its discretion regarding entry of supplemental replies or preventing the filing of superfluous supplemental replies. The requirements for an explanation of why a supplemental response "could not" have been presented earlier, and a compelling reason to enter the supplemental response, are highly subjective. By definition any amendment or argument that could be made at one time in a reexamination "could" have been made at another time. Thus the "could not" standard is impossible to satisfy in a literal sense. At least this standard should be replaced with a still ambiguous, but possible, "was not" standard. The rule also provides no guidance as to whether a particular explanation would be reasonable, or

whether a particular reason would be compelling. Accordingly, under the proposed rule: (i) the patent owner is required to make statements that it otherwise would not, (ii) the Patent Office is provided with no guidance by which to make predictable decisions based on the patent owner's statements, and (iii) in view such unpredictability, the patent owner will have no way to make a reasoned decision about whether a supplemental reply would be appropriate in a given circumstance. It appears to us that the requirements of Proposed 37 C.F.R. § 1.945(b)(2) and (3) heighten and obfuscate the obligations of the patent owner without providing a clear benefit to the Patent Office, the requester, or the patent owner.

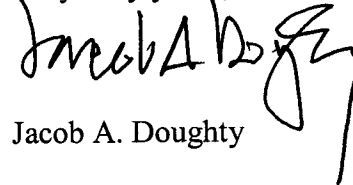
In view of the foregoing, we suggest that Proposed 37 C.F.R. § 1.945(b) be revised to read as follows:

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by an explanation of how the requirements of § 1.111(a)(2)(i) are satisfied.

We would greatly appreciate your careful consideration of the comments and proposal set forth above. Of course, please do not hesitate to contact us if you have any questions.

Best regards.

Very truly yours,



Jacob A. Doughty

JAD/hs

cc: William P. Berridge, Esquire